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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

<u>In Re Application of</u>	:	July 25, 2007
<u>Mark R. Stiffler</u>		Group Art No. 3629
<u>Serial No. 09/891,163</u>		Examiner: J. Plucinski
<u>Filed: June 25, 2001</u>		for IBM Corporation Anne Vachon Dougherty 3173 Cedar Road Yorktown Hts, N.Y. 10598
Title: METHOD AND SYSTEM FOR ADMINISTERING COMPLIANCE WITH INTERNATIONAL SHIPPING REQUIREMENTS		

Board of Patent Appeals and Interferences
Washington, D.C. 20231

APPEAL BRIEF (37 CFR 41.37)

Appellant hereby appeals to the Board of Patent Appeals and Interferences from the decision dated January 25, 2007 the Examiner finally rejecting Claims 1-16 and 62-68 in the above-identified patent application, and respectfully requests that the Board of Patent Appeals and Interferences consider the arguments presented herein and reverse the Examiner's rejection.

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I. REAL PARTY IN INTEREST

The appeal is made on behalf of International Business Machines Corporation, the Assignee of the subject application, and the inventor, Mark R. Stiffler, who are real parties in interest with respect to the subject patent application.

II. RELATED APPEALS AND INTERFERENCES

There are no pending related appeals or interferences with respect to the subject patent application.

III. STATUS OF CLAIMS

There are twenty-three (23) claims pending in the subject patent application, numbered 1-16 and 62-68. No claims stand allowed. A complete copy of the claims involved in the appeal is attached hereto.

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IV. STATUS OF AMENDMENTS

There are no amendments filed after final rejection for the application.

V. SUMMARY OF INVENTION

The present invention relates to methods and systems for facilitating international shipment of goods that enable centralized control of both the establishment of and any changes to international shipping requirements. In accordance with the invention, users can query the system through remote terminals to request requirements for one or more specified countries. Requirement information is provided in response to the request for requirements. The requirement information may be provided in matrix format showing of core requirements relating to all shipments and country specific requirements relating to specified origination and/or destination countries.

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Independent Claims 1 and 62

Independent Claims 1 recites a method (Fig. 9) operable on a computer for distributing requirements to facilitate international shipping. The method comprises steps of storing on the computer core requirements applicable to a plurality of countries and country-specific requirements applicable to respective countries (compliance database 18 of Fig. 1, and page 5, lines 19-30); receiving a request from a requester for requirements for one or more selected countries (step 92 of Fig. 9 and page 11, lines 1-2); determining if country-specific requirements are stored on said computer for said one or more selected countries (step 104 of Fig. 9); providing core requirements to the requester (step 98 and page 11, lines 12-13); and providing, if country-specific requirements are stored on said computer for said one or more selected countries, said country-specific requirements to said requester (step 98 and page 11, lines 15-16). Independent Claim 62 also recites a method operable on a computer for distributing requirements to facilitate international shipping. The method comprises steps of storing on the computer core requirements applicable to a plurality of countries and country-specific

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requirements applicable to respective countries (compliance database 18 of Fig. 1, and page 5, lines 19-30), but also includes storing country-specific summary requirements (page 9, line 20 and lines 28-29). Claim 62 further recites receiving a request from a requester for summary requirements for a selected country (step 92 of Fig. 9 and page 11, lines 1-2); determining if country-specific requirements and summary requirements are stored on said computer for the selected country (step 104 of Fig. 9); and providing country-specific summary requirements to the requester (step 98 and page 11, lines 12-16) to the requester.

Independent Claims 4 and 65

Independent Claim 4 recites a system (Fig. 1) for distributing requirements to facilitate international shipping comprising a processor (12 of Fig, 1); a memory operatively connected to said processor and storing instructions for controlling the operation of said processor (Control Program 19 of Fig. 1) to perform the steps of storing on the computer core requirements applicable to a plurality of countries and country-specific requirements

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applicable to respective countries (compliance database 18 of Fig. 1, and page 5, lines 19-30); receiving a request from a requester for requirements for one or more selected countries (step 92 of Fig. 9 and page 11, lines 1-2); determining if country-specific requirements are stored on said computer for said one or more selected countries (step 104 of Fig. 9); providing core requirements to the requester (step 98 and page 11, lines 12-13); and providing, if country-specific requirements are stored on said computer for said one or more selected countries, said country-specific requirements to said requester (step 98 and page 11, lines 15-16). Independent Claim 65 recites that the system stores summary requirements (country matrix 70 of Fig. 1 and page 9, lines 28-29) and, in response to receipt of a request for summary requirements (172 of Fig. 13), retrieving (steps 174 and 176 of Fig. 13) and sending the summary requirements (178 of Fig. 13) to the requester.

Independent Claims 7 and 68

Independent Claim 7 recites a program product containing a program operable on a computer for distributing requirements to facilitate international shipping, said

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program product comprising instructions for operating said computer to perform the steps of storing on the computer core requirements applicable to a plurality of countries and country-specific requirements applicable to respective countries (compliance database 18 of Fig. 1, and page 5, lines 19-30); receiving a request from a requester for requirements for one or more selected countries (step 92 of Fig. 9 and page 11, lines 1-2); determining if country-specific requirements are stored on said computer for said one or more selected countries (step 104 of Fig. 9); providing core requirements to the requester (step 98 and page 11, lines 12-13); and providing, if country-specific requirements are stored on said computer for said one or more selected countries, said country-specific requirements to said requester (step 98 and page 11, lines 15-16). Independent Claim 68 further recites the storing of summary requirements (country matrix 70 of Fig. 1 and page 9, lines 28-29) and, in response to receipt of a request for summary requirements (172 of Fig. 13), retrieving (steps 174 and 176 of Fig. 13) and sending the summary requirements (178 of Fig. 13) to the requester.

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Independent Claim 8

Independent Claim 8 recites a method operable on a computer of obtaining international shipping requirements, comprising the steps of requesting, on said computer, international shipping requirements for one or more selected countries (page 11, lines 2-3); receiving, on said computer, core international shipping requirements applicable to a plurality of countries (page 11, line 12); and receiving, on said computer, an indication of respective country-specific requirements available for said one or more selected countries (page 11, line 14).

Independent Claim 12

Independent Claim 12 recites a system (user terminal 16 of Fig. 1) for obtaining international shipping requirements, comprising a processor (page 19, line 22) and a memory storing instructions to control the operation of the processor to perform steps of requesting, on said computer, international shipping requirements for one or more selected countries (page 11, lines 2-3); receiving, on said computer, core international shipping requirements

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applicable to a plurality of countries (page 11, line 12); and receiving, on said computer, an indication of respective country-specific requirements available for said one or more selected countries (page 11, line 14).

Independent Claim 16

Independent Claim 16 recites a program product for operating a computer to perform steps of requesting, on said computer, international shipping requirements for one or more selected countries (page 11, lines 2-3); receiving, on said computer, core international shipping requirements applicable to a plurality of countries (page 11, line 12); and receiving, on said computer, an indication of respective country-specific requirements available for said one or more selected countries (page 11, line 14).

Dependent Claims 2, 5, 10 and 14

Dependent Claims 2, 5, 10 and 14 recite the claim features, detailed above, of the respective independent claims from which they depend, and further recite that storing, requesting, determining, retrieving and providing

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are for requirements for a plurality of countries (Figs. 4A and 4B).

Dependent Claims 3, 6, 11, 15, 63, 64, 66 and 67

Dependent Claims 3, 6, 11, 15, 63, 64, 66 and 67 recite the claim features, detailed above, of the respective independent claims from which they depend, and further recite that the providing and receiving of requirements are in matrix chart format (Fig. 7).

VI. GROUNDS OF REJECTION TO BE REVIEWED

The grounds of rejection to be reviewed are:

- (1) Claims 1, 4, 7-9, 12-13, 16, 62, 65 and 68 have been rejected under 35 USC 102(e) as being anticipated by Lederer;
- (2) Claims 2, 5, 10 and 14 have been rejected as either anticipated or obviated by Lederer; and,

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(3) Claims 3, 6, 11, 15, 63-64 and 66-67 have been rejected under 35 USC § 103 as being unpatentable over Lederer.

VII. ARGUMENT

Claims 1, 4, 7, 62, 65 and 68

The Lederer patent publication is directed to an order processing system wherein a Global Regulatory Compliance System (GRCS) receives product orders and determines whether it can process the order (paragraph [0072], lines 1-2). The GRCS determines whether the customer and product specified in the order are known to the GRCS system (paragraph [0072], lines 2-4). If the customer and product are known to the GRCS, then the GRCS determines whether a Material Safety Data Sheet (MSDS) identifying the product constituents is stored for the ordered product. If so, the MSDS is consulted and the GRCS determines whether the product can be shipped to the indicated order destination given on the product constituents (paragraph [0077], lines 1-7). If the product can be shipped, the GRCS may either send an indication that the shipment is permitted or be silent and

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have silence construed as an indication that shipment is permitted (paragraph [0077], lines 8-15). If an MSDS does not exist, the GRCS may transmit an MSDS to be completed for the ordered product. The GRCS makes its determination of whether a product can be shipped to the indicated order destination based on information obtained by the GRCS from other sources, including a product information system and a regulation source system maintained by an independent regulatory agency (108 and 112 respectively as illustrated in Fig. 1; see: paragraphs [0044] and [0045]).

Appellant respectfully asserts that the Lederer patent publication does not anticipate the invention as claimed. The present invention teaches and claims a method, system and program storage product that includes steps and means for storing core requirements applicable to a plurality of countries as well as country-specific requirements. Lederer does not store core requirements or country-specific requirements. Rather, Lederer contacts a regulation source system to obtain regulation information. Further, the present claims recite steps and means for receiving a request from a requester for requirements for one or more selected countries. The GRCS system in Lederer receives a

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product order. The pending claims recite steps and means for determining if country-specific requirements are stored for the one or more selected countries. Lederer determines whether the product and customer specified in the order are known to the GRCS system. The claims recite steps and means for providing core requirements and available country-specific requirements to the requester. In contrast, Lederer sends an indication of whether the ordered product can be shipped. Clearly the Lederer patent publication does not anticipate the invention as set forth in the pending claims.

Lederer also teaches that a user may request "a specific compliance-related document from the GCRS" [0080]; however, receiving a request for a specific document is not the same as or suggestive of receiving a request for requirements for a specific country.

Lederer further teaches that, if it can successfully process an order, it may then access compliance information [0054] and may prepare one or more reports and forward the reports to "appropriate parties" [0055] or "interested parties" [0038]. However, Lederer does not teach that compliance information is requested for specific countries,

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that compliance information is retrieved in response to a request for country-specific requirements, or that country-specific requirements are sent to the requester. Rather, Lederer sends an indication to the requester of whether or not the order can be processed in response to a product order.

Anticipation under 35 USC 102 is established only when a single prior art reference discloses each and every element of a claimed invention. See: In re Schreiber, 128 F. 3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F. 3d 1475, 1478-1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 911 F. 2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F. 2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Since the Lederer patent publication does not teach the system, program product and method including steps and means for storing core requirements and country-specific requirements, receiving a request for requirements for at least one selected country and providing core requirements and available country-specific requirements to the requester, it cannot be maintained that Lederer anticipates the language of independent Claims 1, 4,

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7, 62, 65 and 68 or the claims which depend therefrom and add limitation thereto.

Claims 8, 12 and 16

With respect to independent Claims 8, 12 and 16, Lederer does not teach a system, method or program product including means and steps for requesting, on a computer, international shipping requirements for at least one selected country; receiving, on the computer, core international shipping requirements applicable to a plurality of countries and an indication of respective country-specific requirements available for the at least one selected country. Rather, Lederer expressly teaches that a product order is submitted and an indication of whether the order can be filled is received at the requester. Appellant notes that the Examiner has cited the same paragraphs [0038] and [0040] against the claims directed to a system, method and program product for a system storing the requirements and responding to requests, (Claims 1, 4, 7, 62, 65 and 68) and have been cited against the claims directed to a system, method and program product for a system requesting requirements (Claims 8, 12 and 16). Clearly the same

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teachings cannot anticipate the two distinct sets of claims. Based on the arguments set forth above, Appellant believes that Lederer does not anticipate the invention as recited in Claims 8, 12 and 16 and those claims which depend therefrom and add limitations thereto.

Claims 2, 5, 10 and 14

Claims 2, 5, 10 and 14 have also been rejected as anticipated by Lederer, or, in the alternative, unpatentable over Lederer. Appellant relies on the arguments presented above with respect to the claim features of Claims 1 and 4 from which Claims 2 and 5 respectively depend and on the arguments presented above with respect to the claim features of Claims 8 and 12 from which Claims 10 and 14 respectively depend.

Claims 2 and 5 recite receiving a request for requirements for a plurality of countries and further including steps of determining if respective country-specific requirements are stored for respective ones of the plurality of countries and, if stored, providing the respective country-specific requirements to the requester.

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Appellant respectfully asserts that the Lederer publication expressly teaches that a product order is received. Lederer does not receive a request for requirements for a plurality of countries. Further, Lederer's GRCS determines if a product can be shipped; it does not determine if country-specific requirements are stored for respective ones of a plurality of countries. Finally, Lederer's GRCS sends an indication of whether an ordered product can be shipped. Lederer does not provide respective country-specific requirements for respective ones of a plurality of countries. Since Lederer does not teach the claimed steps and means, it cannot be maintained that Lederer anticipates the invention as claimed in Claims 2 and 5.

Claims 10 and 14 recite requesting requirements for a plurality of countries and receiving respective country-specific requirements. Appellant respectfully asserts that the Lederer publication expressly teaches that a product order is the request. Lederer does not send a request for requirements for a plurality of countries. Further, Lederer's GRCS requester does not receive respective country-specific requirements for respective ones of a plurality of countries. Rather, Lederer's product

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orderer receives an indication of whether the product order will be filled. Since Lederer does not teach the claimed steps and means, it cannot be maintained that Lederer anticipates the invention as claimed in Claims 10 and 14.

The Examiner states that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the request be for multiple countries, since it had been held that a mere multiplicity of parts of steps involves only routine skill in the art". Appellant first contends that Lederer does not teach or suggest a product order for multiple countries. Obviousness cannot be maintained without some teaching or suggestion of the claim features. The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." (In re Lee, 277 F. 3d 1338, 1343 (Fed. Cir. 2002)). Moreover, the Federal Circuit has stated that "conclusory statements" by an Examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief

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and unknown authority" (Id. at 1343-1344). One would not be motivated by Lederer's teachings to submit a product order for shipping to multiple locations.

Appellant further contends that to perform a multiplicity of Lederer steps would be submitting multiple product orders and not an order for delivery to multiple countries. Further, even if Lederer did submit multiple product orders, the GRCS would still respond with "an indication of whether the product can be shipped" and not the requirements as claimed by Claims 2 and 5.

The Examiner further states that "it would have been obvious to Lederer (*sic*) to have the request be for multiple carriers, do (*sic*) to the fact that requesting information on multiple countries, would have been at the level of ordinary skill in the art". Appellant argues that a determination of what would have been obvious "to Lederer" is not an appropriate legal standard for obviousness. Further, even if requesting information on multiple countries may have been "at the level of ordinary skill in the art", without some teaching or suggestion by Lederer or another reference, an obviousness conclusion is a conclusory statement based on 20:20 hindsight and is not based on a

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teaching or suggestion provided by the cited art. Accordingly, Appellant believes that the rejections cannot be sustained.

Claims 3, 6, 11, 15, 63-64 and 66-67

With regard to Claims 3, 6, 11, 15, 63-64 and 66-67, which have been rejected under 35 USC § 103 as being unpatentable over Lederer, Appellant relies on the arguments set forth above with respect to the teachings of Lederer which do not anticipate the features of the independent claims from which Claims 3, 6, 11, 15, 63-64 and 66-67 depend. Moreover, Appellant contends that Lederer does not teach or suggest providing its regulations in a matrix format. Since Lederer teaches that it sends an indication of whether a product can be shipped, or even allows a lack of response to indicate that a product can be shipped [0077], it cannot be maintained that Lederer teaches or suggests multiple results, let alone that the results be rendered in a matrix format. Similarly, Lederer sending a specific document [0080] in response to a specific request does not anticipate or obviate sending multiple results to a requirements request in a matrix format. Finally, Lederer

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formulating reports [0038] and [0055] is not the same as or suggestive of providing requirements for specific countries in a matrix format.

Appellant respectfully asserts that, for a determination of obviousness, the prior art must teach or suggest all of the claim limitations. "All words in a claim must be considered in judging the patentability of that claim against the prior art" (In re Wilson, 424 F. 2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). If the cited references fail to teach each and every one of the claim limitations, a *prima facie* case of obviousness has not been established by the Examiner. Since Lederer does not teach all of the limitations of the claims, a rejection under 35 USC 103 cannot be maintained.

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CONCLUSION

Appellant respectfully asserts that the Examiner has erred in rejecting Claims 1-2, 4-5, 7-10, 12-14, 16, 62, 65 and 68 under 35 USC 102(b) as anticipated by Lederer and has erred in rejecting Claims 2-3, 5-6, 10-11, 14-15, 63-64 and 66-67 as unpatentable over the teachings of Lederer. Appellant requests that the decision of the Examiner, rejecting all of the pending claims, be overturned by the Board and that the claims be passed to issuance.

Respectfully submitted,
Mark R. Stiffler

By: /Anne Vachon Dougherty/
Anne Vachon Dougherty
Registration No. 30,374
Tel. (914) 962-5910

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APPENDIX OF CLAIMS

1. A method operable on a computer for distributing requirements to facilitate international shipping, comprising the steps of:

storing on said computer core requirements applicable to a plurality of countries;

storing on said computer respective country-specific requirements applicable to respective countries;

receiving a request from a requester for requirements for one or more selected countries;

determining if country-specific requirements are stored on said computer for said one or more selected countries;

providing said core requirements to said requester; and

providing, if country-specific requirements are stored on said computer for said one or more selected countries, said country-specific requirements to said requester.

2. A method in accordance with claim 1 wherein said step of receiving a request comprises receiving a request for requirements for a plurality of countries; and further including the steps of:

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determining if respective country-specific requirements are stored on said computer for respective ones of said plurality of countries;

providing, if respective country-specific requirements are stored on said computer for respective ones of said plurality of countries, said respective country-specific requirements to said requester.

3. A method in accordance with claim 1 and further including the step of providing said core requirements and said respective country-specific requirements in a matrix chart format.

4. A system for distributing requirements to facilitate international shipping, comprising:

a processor;

a memory operatively connected to said processor and storing instructions for controlling the operation of said processor to perform the steps of:

storing core requirements applicable to a plurality of countries;

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storing respective country-specific requirements
applicable to respective countries;

receiving a request from a requester for requirements
for one or more selected countries;

determining if country-specific requirements are stored
for said one or more selected countries;

providing said core requirements to said requester; and

providing, if country-specific requirements are stored
for said one or more selected countries, said
country-specific requirements to said requester.

5. The system of claim 4 wherein said step of receiving a
request comprises receiving a request for requirements for a
plurality of countries; and further including the steps of:

determining if respective country-specific requirements
are stored for respective ones of said plurality of
countries;

providing, if respective country-specific requirements
for respective ones of said plurality of countries, said
respective country-specific requirements to said requester.

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6. The system of claim 4 and further including the step of providing said core requirements and said respective country-specific requirements in a matrix chart format.

7. A program product containing a program operable on a computer for distributing requirements to facilitate international shipping, said program product comprising instructions for operating said computer to perform the steps of:

storing core requirements applicable to a plurality of countries;

storing respective country-specific requirements applicable to respective countries;

receiving a request from a requester for requirements for one or more selected countries;

determining if country-specific requirements are stored for said one or more selected countries;

providing said core requirements to said requester; and

providing, if country-specific requirements are stored for said one or more selected countries, said country-specific requirements to said requester.

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8. A method operable on a computer of obtaining international shipping requirements, comprising the steps of:

requesting, on said computer, international shipping requirements for one or more selected countries;

receiving, on said computer, core international shipping requirements applicable to a plurality of countries;

receiving, on said computer, an indication of respective country-specific requirements available for said one or more selected countries.

9. A method in accordance with claim 8 and further including the step of receiving, on said computer, if respective country-specific requirements are available for said one or more selected countries, said respective country-specific requirements.

10. A method in accordance with claim 9 wherein said requesting step includes requesting, on said computer, international shipping requirements for a plurality of selected countries; and further comprising the steps of

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receiving, on said computer, said core requirements and, if respective country-specific requirements are available for one or more of said plurality of selected countries, said respective country-specific requirements.

11. A method in accordance with claim 8 wherein said core and said respective country-specific requirements are received in a matrix chart format.

12. A system for obtaining international shipping requirements, comprising:

a processor;

a memory connected to said processor and storing instructions to control the operation of said processor to perform the steps of:

requesting international shipping requirements for at least one selected country;

receiving core international shipping requirements applicable to a plurality of countries;

receiving an indication of respective country-specific requirements available for said at least one selected country.

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13. A system in accordance with claim 12 and further including the step of receiving, if respective country-specific requirements are available for said selected country, said respective country-specific requirements.

14. A system in accordance with claim 13 wherein said requesting step includes requesting international shipping requirements for a plurality of selected countries; and further comprising the steps of

receiving said core requirements and, if respective country-specific requirements are available for one or more of said plurality of selected countries, said respective country-specific requirements.

15. A system in accordance with claim 12 wherein said core and said respective country-specific requirements are received in a matrix chart format.

16. A program product containing a program operable on a computer for obtaining international shipping requirements,

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said program product comprising instructions for operating said computer to perform the steps of:

requesting, on said computer, international shipping requirements for at least one selected country;

receiving, on said computer, core international shipping requirements applicable to a plurality of countries;

receiving, on said computer, an indication of respective country-specific requirements available for said at least one selected country.

17-61 (withdrawn)

62. A method operable on a computer for distributing requirements to facilitate international shipping, comprising the steps of:

storing on said computer core requirements applicable to a plurality of countries;

storing on said computer respective country-specific requirements applicable to respective countries;

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storing on said computer country-specific summary requirements corresponding to said country-specific requirements;

receiving a request for a summary report of requirements for at least one selected country;

determining if country-specific requirements are stored on said computer for said at least one selected country; and

providing, if country-specific requirements are stored on said computer for said at least one country, said country-specific summary requirements to said requester.

63. A method in accordance with claim 62 wherein said country-specific summary requirements are provided in a matrix chart format.

64. A method in accordance with claim 63 and further including the steps of:

storing on said computer core summary requirements corresponding to said core requirements; and

providing said core summary requirements to said requester in said matrix chart format.

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65. A system for distributing requirements to facilitate international shipping, comprising:

a processor;

a memory connected to said processor and containing instructions for controlling the operation of said processor to perform the steps of:

storing core requirements applicable to a plurality of countries;

storing respective country-specific requirements applicable to respective countries;

storing country-specific summary requirements corresponding to said country-specific requirements;

receiving a request from a requester for a summary report of requirements for at least one selected country;

determining if country-specific requirements are stored for said selected country; and

providing, if country-specific requirements are stored for said at least one country, said country-specific summary requirements to said requester.

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66. The system of claim 65 wherein said country-specific summary requirements are provided in a matrix chart format.

67. The system of claim 66 and further including the steps of:

storing core summary requirements corresponding to said core requirements; and

providing said core summary requirements to said requester in said matrix chart format.

68. A program product containing a program operable on a computer for providing a test for comparing the compliance of an international shipment with requirements for international shipping, said program product comprising instructions for operating said computer to perform the steps of:

storing core requirements applicable to a plurality of countries;

storing respective country-specific requirements applicable to respective countries;

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storing country-specific summary requirements
corresponding to said country-specific requirements;
receiving a request from a requester for a summary
report of requirements for at least one selected country;
determining if country-specific requirements are stored
for said at least one selected country; and
providing, if country-specific requirements are stored
for said at least one country, said country-specific summary
requirements to said requester.

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EVIDENCE APPENDIX

There has been no additional evidence presented.

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RELATED PROCEEDINGS APPENDIX

There are no related proceedings.